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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/557,106	12/11/2006	Sylvaine Le Roy-Delage	21.1244	5357

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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06/30/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/557,106	Applicant(s) LE ROY-DELAGE ET AL.	
	Examiner Paul Marcantoni	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments filed 4/13/10 have been fully considered but they are not persuasive. The applicants' amendment necessitated rejection of claims previously non-elected as applicants amended *system* to composition and they were included now in the rejected claims below.

Obviousness Type Double Patenting:

The ODP rejection has been withdrawn because applicants' submitted on proper terminal disclaimer in their 4/13/10 response.

35 USC 102/103:

Claims 1-3 and 5-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2001 146457 (X reference from Int'l Search Report), ZA 9100876 (X reference from Int'l Search Report), Heathman et al. '990, Montgomery '012, '636, '503, '633, Darwin '158 or '343, or Creel '802 A1.

Note: Reddy et al. '841 has been withdrawn as it does not teach cement. Also, Pageau '302 A1 has been withdrawn because applicants provisional application effective filing date pre-dates it. It should be pointed out that if the provisional disclosure did not teach the same features as claimed, however, applicants could not swear back to the effective filing date of provisional application. However, it appears it does teach same disclosure in provisional and regular application so this is not an issue.

All of the above cited references teach a composition containing what applicants call a super absorbent polymer thus anticipating applicants claims (see claim of these respective prior art references). Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

See for example, claim 20 on p.5 for polymethacrylate and polyacrylamide for Heathman et al. '990 A1; col.7, lines 50-60 of Montgomery '012 teaching

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polymethacrylate; Montgomery '636 col.8, line 13 teaching polymethacrylate; Note Darwin '158, for example teach imidized acrylic polymers which read upon non-soluble acrylic polymers or the broad polymer water absorbent material of applicants' claim 1; Reddy et al. '841 B2 teach polyacrylamide in claim 2; Creel et al. teach adding polyacrylamide or polyacrylate in claim 4; and Pageau teaches acrylic polymers in their claims for adding to cement (see claim 1).

The use of conventional additives such as retarders, accelerators (e.g. calcium chloride), dispersants, etc. is conventional in the cement art (See MPEP 2144).

Response to Applicants' Arguments:

The applicants have added a process limitation to independent claim 1 product claim that the super absorbent polymer is added to the slurry *dry blended* with the cement. In other words, the polymer and the cement must first be mixed together (it appears as this is critical) and then it can be added to the slurry (water). However, the prior art still teaches all the same components and it is unclear if they dry blend or not. However, changes in sequence of adding ingredients for process claims (not product claims) is not a patentable distinction unless criticality can be shown. Applicants only provide process limitations to the product claims. It may very well be that the prior art does not teach dry blending polymer and cement first but even if it did not and the mixing order were different or simultaneous (mixing of all ingredients), applicants have not shown that the final resultant properties are different. The final product would still appear the same despite potentially different order of mixing as it contains the same

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components. Product by Process claims do not patentably distinguish the product of reference even though made by a different process.” In re Thorpe , 227 USPQ 964.

The applicants point out that JP ‘457 is a mortar or paste yet it would appear that a mortar can still be pumpable by adding more water. The applicants also argue a different intended use than the one for their instantly claimed invention. However, the new use of a known composition is not a patentable distinction. The same is true for ZA ‘876. If the prior art teaches the same components, it would have been expected to have the same properties regardless of specific or different intended use.

The applicants appear to argue the process of Heathman instead of contemplating the final product which includes a thickener that can be ultimately in the cement slurry so this it still meets the applicants’ claimed composition for well cement slurry. Had applicants been claiming the process and arguing that, this may be convincing but the problem is the product claim is the issue and the final product of Heathman still contains the polymer, water, and cement. Applicants again argue order of mixing to show criticality but that again is a process limitation. Further, as recited in *In re Thorpe*, a product can be made by a different process (ie different order of mixing) and still result in the same product absent evidence to the contrary.

The applicants argue Montgomery that it is a different purpose (improve flowability). The examiner notes that the purpose or intended use does not control whether or not the product claim is allowable. If the prior art teaches the same components it is expected to have the same properties regardless of a different purpose/intended use

The applicants argue the order of mixing which could be argued is a different process for Creel. Yet, as indicated in in re Thorpe above, a product can be made by a different process (different order of mixing of same components) and still obtain the same product. Applicants have not shown this critical; that the order of mixing leads to a product as claimed with different properties.

The applicants final closing paragraph in their response reemphasizes the aims or objectives of the inventors and note that none of the prior art teaches the specific purpose as in their claimed invention. Again, the purpose or intended use of a known composition is not a patentable distinction. Applicants must show that the claimed product has features that differ over the prior art. It appears though the order of mixing the same components could differ, applicants have not shown the final properties of their claimed cement slurry product versus the prior art to be different and thus the rejection over the art stands.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793